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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,605	04/30/2001	Akira Ichikawa	Q64273	9350

7590 05/16/2005

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,605

Applicant(s)

ICHIKAWA ET AL.

Examiner

Victor S. Chang

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1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/15/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 4/15/2005. Applicants' amendment to claims 1 and 6 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicants' amendments and arguments have been fully considered, however, Applicants' arguments are moot in view of a different interpretation of the previously applied reference.

Drawings

4. Upon reconsideration, it is noted that Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (see specification, page 1, bottom paragraph). See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Rejections Based on Prior Art

5. Claims 1, 2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimura et al. (US 6065701) in view of Applicants' admission, generally as set forth in sections 5 and 6 of Office action dated 10/19/2004, together with the following response to argument.

It is noted that claim 1 has been amended to recite, *inter alia*, "wherein said electronic components are sequentially laminated and said adhesive layer is in direct contact with said electronic components and is suitable for application to an article, when said adhesive label is applied to an article, said adhesive layer comes into direct contact with the surface of the article".

First, for the purpose of clarification, the Examiner repeats the relied upon prior art as follows: Tanimura's invention is directed to a label comprising electronic components (Abstract). In Fig. 2, Tanimura shows an adhesive label having an antenna wiring and an IC (electronic components) formed on a polyimide substrate 16, and an adhesive layer 17. An exfoliative paper 18 (release layer) is laminated on the adhesive layer 17, which is a layer of "both faces adhesive material" (i.e., double sided pressure sensitive adhesive layer) for adhering the label to a video cassette tape (column 4, lines 7-8). Tanimura also teaches a coated paper layer 12 as an outer surface layer for carrying information such as the title, recording date, and recording place of the video data recorded on a video tape (column 3, lines 52-56).

For claims 1 and 2, it is noted that Tanimura lacks a teaching that the adhesive layer 17 is formed on a substrate surface which is in direct contact with the electronic

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component. However, the Examiner repeats that Applicants have admitted that an adhesive label containing a contact-less data carrier element mounted on one or both surfaces of a circuit substrate, with connecting through-hole in the latter case, is conventional and well known (Specification, pages 1-2, bridging paragraph). As such, it would have been obvious to one of ordinary skill in the art to optionally mount the contact-less data carrier element mounted on one or both surfaces of a circuit substrate. It should be noted that the selection of a known equivalent device based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

For claim 4, Fig. 2 clearly shows that adhesive layer 17 covers the electronic components (i.e., the entire data carrier element).

For claims 5 and 7, Tanimura's coated paper layer 12 reads on the surface layer as claimed.

Finally, for claim 6, which has been amended to recite, *inter alia*, "a surface layer is formed directly on the other of said separately formed electronic components", the Examiner notes that in the absence of a specific definition of what constitutes a "surface layer", structurally and compositionally, in the specification or in claim 6, the multilayer structure of layers 12, 13, 14 and 15 reads on the "surface layer" of instant invention as claimed.


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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Victor S Chang
Examiner
Art Unit 1771

5/5/2005